

REMARKS

In the Final Office Action, the Examiner rejected claims 1-14 and 16-27. By this Response, Applicants amend claims 1, 8, 16, 21, 24, and 26-27, cancel claim 23 and add new claims 28-39. These amendments do not add new matter. Currently, claims 1-14, 16-22 and 24-39 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and following remarks, Applicants respectfully request allowance of all pending claims.

Rejection Under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 1-2, 21 and 26 as anticipated by Reames et al. (U.S. Patent No. 6,174,482, hereinafter the "Reames" reference), claims 1, 3-4, 9, 16 and 18-27 as anticipated by Ohgami et al. (U.S. Patent No. 5,574,625, hereinafter the "Ohgami" reference) and claims 1, 3-4, 7, 9, 16, 18-22 and 24-26 as anticipated by Yang et al. (U.S. Patent No. 6,781,819, hereinafter the "Yang" reference). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention "in as complete detail as contained in the ... claim" to support a prima facie case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Further, the pending claims must be given an interpretation that is reasonable and consistent with the *specification*. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969) (emphasis added); M.P.E.P. §§ 608.01(o) and 2111. Indeed, the specification is "the primary basis for construing the claims." See *Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005) (*en banc*). One should rely *heavily* on the written description for guidance as to the meaning of the claims. See *Id.*

Interpretation of the claims must also be consistent with the interpretation that *one of ordinary skill in the art* would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. § 2111. "The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." See *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) (quoting *Phillips*, No. 03-1269, -1286, at 16). The Federal Circuit has made clear that derivation of a claim term must be based on "usage in the ordinary and accustomed meaning of the words amongst artisans of ordinary skill in the relevant art." See *Id.*

First Rejection

In the Final Office Action, the Examiner rejected claims 1-2, 21 and 26 as anticipated by the Reames reference. Applicants respectfully traverse this rejection.

Claim 1 and its Dependent Claims

The Reames reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "a display having a resilient pad," as recited by independent claim 1. (Emphasis added.) In contrast, the Reames reference teaches a glass sheet 112 mounted in a frame 125 without a resilient pad. See *e.g.* Reames Fig. 13. Indeed, the Reames reference does not teach a pad of any sort, let alone a resilient pad. Thus, the Reames reference could not possibly teach *all* of the features of claim 1. In view of these deficiencies, among others, the cited reference cannot anticipate claim 1 or the claims that depend therefrom.

Claim 21 and its Dependent Claims

Here again, the Reames reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest "a shock absorbing pad disposed between the top surface of the display and the housing," as recited by independent claim 21. (Emphasis added.) In contrast, as discussed above, the Reames reference teaches a glass sheet 112 mounted in a frame 125 without a pad between the glass sheet 112 and the frame 125. *See id.* Thus, the Reames reference could not possibly teach *all* of the features of claim 21. In view of these deficiencies, among others, the cited reference cannot anticipate claim 21 or the claims that depend therefrom.

Second Rejection

In the Final Office Action, the Examiner rejected claims 1, 3-4, 9, 16 and 18-27 as anticipated by the Ohgami reference. Applicants respectfully traverse this rejection.

Claim 1 and its Dependent Claims

The Ohgami reference is deficient for a number of reasons, including reasons similar to those discussed above. For example, the cited reference does not teach or suggest "a display having a resilient pad," as recited by independent claim 1. (Emphasis added.) In sharp contrast, the Ohgami reference teaches a transparent protective cover 18 that is fixed to the flange 61 of the upper case 11 by means of the double-coated tape 62. *See* Ohgami, col. 7, ll. 51-53; and Fig. 8. Ohgami does not teach or suggest that this double-coated tape 62 is a pad, let alone that it is a resilient pad. Indeed, the Ohgami reference states that the transparent protective cover 18 is "fixed to the upper surface of the flange 61 through [the] double-coated tape 62." *See id.* at col. 6, ll. 65-67 (emphasis added). In other words, the double-coated tape 62 is not resilient according to the express teaching of the Ohgami reference. Therefore, the Ohgami reference could not possibly teach *all* of the features of claim 1. In view of these deficiencies, among others, the cited reference cannot anticipate claim 1 or the claims that depend therefrom.

Additionally, the Ohgami reference does not teach or suggest “a display having a resilient pad.” The double-coated tape 62 is separate from the display device 58. *See id* at Fig. 8. The double-coated tape 62 secures the transparent protective cover 18 to a flange 61. *See id*. Indeed, the double-coated tape 62 disclosed by the Ohgami reference is not even in contact with the display device 58. Therefore, for this reason also, the Ohgami reference does not anticipate claim 1 or its dependent claims.

Claim 16 and its Dependent Claims

Here again, the Ohgami reference is deficient for a number of reasons. For instance, the cited reference does not teach or suggest “applying a shock absorbing pad to the portable computer housing,” as recited by independent claim 16. (Emphasis added.) In sharp contrast, as discussed above, the Ohgami reference teaches a transparent protective cover 18 that is fixed to the flange 61 of the upper case 11 by means of the double-coated tape 62. The Ohgami reference does not teach or suggest that this double coated tape 62 is a pad, much less a shock absorbing pad, or that the tape 62 itself is somehow shock absorbing. As discussed above, the Ohgami reference states that the transparent protective cover 18 is “fixed to the upper surface of the flange 61 through [the] double-coated tape 62,” indicating that the double-coated tape 62 is not shock absorbing. *See id* at col. 6, ll. 65-67 (emphasis added). Thus, the Ohgami reference could not possibly teach *all* of the features of claim 16. In view of these deficiencies, among others, the cited reference cannot anticipate claim 16 or the claims that depend therefrom.

Additionally, the Ohgami reference does not teach or suggest that “the shock absorbing pad is disposed between the display panel and the portable computer housing.” As illustrated by Fig. 8, the double-coated tape 62 is located between the protective cover 18 and the external side of the flange 61, while the display device 58 is located on the internal side of the flange 61. *See id* at Fig. 8. That is, the double-coated tape 62 is located outside of the housing and the display device is disposed inside of the housing. Thus, the double-coated tape 62 is not disposed between the display device 58 and the housing. *See id*. Accordingly,

for this reason also, the Ohgami reference does not anticipate claim 16 or its dependent claims.

Moreover, Applicants respectfully assert that the structure disclosed by the Ohgami reference does not inherently necessitate the steps recited by claim 16. For example, as discussed above, the structure disclosed by the Ohgami reference does not include a shock absorbing pad. Therefore, the structure disclosed by the Ohgami reference clearly does not inherently necessitate a step of “applying a shock absorbing pad,” as recited by the present claims. Accordingly, for this reason also, Applicants respectfully request allowance of claim 16 and its dependent claims.

Claim 21 and its Dependent Claims

With respect to claim 21 and its dependent claims, the Ohgami reference is deficient for a number of reasons. For instance, as discussed above, the cited reference does not teach or suggest “a shock absorbing pad disposed between the top surface of the display and the housing,” as recited by independent claim 21. (Emphasis added.) To the contrary, the Ohgami reference teaches a transparent protective cover 18 that is fixed to the flange 61 of the upper case 11 by means of the double-coated tape 62. The Ohgami reference does not teach or suggest that this double coated tape 62 is a pad, much less a shock absorbing pad, or that the tape 62 itself is somehow shock absorbing. Further, the Ohgami reference states that the transparent protective cover 18 is “fixed to the upper surface of the flange 61 through [the] double-coated tape 62,” indicating that the double-coated tape 62 is not shock absorbing. *Id* at col. 6, ll. 65-67 (emphasis added). Thus, the Ohgami reference could not possibly teach *all* of the features of claim 21. In view of these deficiencies, the cited reference cannot anticipate claim 21 or the claims that depend therefrom.

Additionally, as discussed above, the Ohgami reference does not teach or suggest “a shock absorbing pad disposed between the top surface of the display and the housing.” As illustrated by Fig. 8, the double-coated tape 62 is located between the protective cover 18 and the external side of the flange 61. *See id* at Fig. 8. However, the display device 58 is located

on the internal side of the flange 61. Thus, the double-coated tape 62 disclosed by the Ohgami reference is not disposed between the display device 58 and the flange 61. Indeed, the double-coated tape 62 is not disposed between the display device 58 and any portion of the housing. *See id.* Therefore, for this reason also, the Ohgami reference does not anticipate claim 21 or its dependent claims.

Third Rejection

In the Final Office Action, the Examiner rejected claims 1, 3-4, 7, 9, 16, 18-22 and 24-26 as anticipated by the Yang reference. Applicants respectfully traverse this rejection.

Removal of the Yang Reference pursuant to 37 C.F.R. § 1.131

The Yang reference is allegedly prior art under 35 U.S.C. § 102(e). Pursuant to 37 C.F.R. § 1.131, the Applicants may remove alleged prior art under Section 102(e) from consideration by filing an appropriate declaration that establishes the invention of the claimed subject matter in the United States, a NAFTA country, or a WTO member country prior to the effective filing date of a cited reference. Prior invention may be shown by demonstrating reduction to practice of the claimed subject matter in the United States, a NAFTA country, or a WTO member country prior to the effective filing date of the cited reference. Here, the Applicants have attached a declaration signed by Steven Homer, an inventor of record, to demonstrate that the invention disclosed and claimed in the present application was conceived and actually reduced to practice in the United States prior to the December 17, 2002, filing date of the Yang reference. *See* M.P.E.P. §§ 715 and 2136.03.

Specifically, in paragraph 3 of the attached Rule 131 Declaration, Steven Homer declares that the subject matter disclosed and claimed in the present application was conceived in the United States prior to December 17, 2002. *See* Rule 131 Declaration of Steven Homer (hereafter referred to the "Declaration"), paragraph 3. In support of the Declaration, Exhibit A includes a redacted and labeled sketch that depicts an embodiment of the claimed subject matter. *See* Exhibit A. Therefore, Applicants submit that Exhibit A and

the Declaration are sufficient to demonstrate conception of the claimed subject matter in the United States prior to the December 17, 2002, filing date of the Yang reference.

Further, the Applicants' date of reduction to practice is amply supported by the Declaration and drawings prepared prior to December 17, 2002. *See* Exhibits B and C and Declaration, paragraph 4. As set forth in the Declaration, an inventor of record, Steven Homer, declares that the drawings identified as Exhibits B and C document the successful construction of a working prototype. *See* Exhibits B and C and Declaration, paragraph 4. Specifically, Exhibits B and C illustrate a tablet computer housing 10 having a top opening with a perimeter edge 12, a controller 14 disposed within the housing 10, and a display assembly or panel 16 disposed in the opening with the perimeter edge 12. *See id.* The display assembly or panel 16 has a top surface 18 that extends to the perimeter edge 12. *See id.* In this illustrated example, the top surface 18 and the perimeter edge 12 form a smooth and uninterrupted surface. *See id.* Further, a pad 20 is located between the housing 10 and the display assembly or panel 16. *See id.* The pad 20 is configured to absorb shock between the housing 10 and the display assembly or panel 16. Thus, attached Exhibits B and C and the Declaration demonstrate a date of actual reduction to practice in the United States prior to the December 17, 2002, filing date of the Yang reference.

In summary, Applicants submit that Exhibits A, B, and C and the Declaration are sufficient to demonstrate conception and subsequent actual reduction to practice of the claimed subject matter in the United States before the apparent effective date of December 17, 2002 of the Yang reference. In view of the evidence discussed above, Applicants respectfully request removal of the Yang reference and withdrawal of the related rejection under 35 U.S.C. § 102.

For these reasons, among others, Applicants respectfully request withdrawal of all rejections with respect to the Yang reference.

Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 2, 5-6, 8, 10-14 and 17 as obvious over the Ohgami reference in view of Hashimoto (U.S. Patent No. 5,442,470) and claims 2, 5-6 and 17 as obvious over the Yang reference in view of Hashimoto (U.S. Patent No. 5,442,470). Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

First Rejection

In the Final Office Action, the Examiner rejected claims 2, 5-6, 8, 10-14 and 17 as obvious over the Ohgami reference in view of the Hashimoto reference. Applicants respectfully traverse this rejection.

Claims 2, 5-6, and 8

Claims 2, 5-6, and 8 depend from claim 1. The rejection of claims 2, 5-6 and 8 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of claim 1 under Section 102. Specifically, the Ohgami reference does not disclose or suggest "a display having a resilient pad," as recited by claim 1. (Emphasis added.) The Ohgami reference discloses a transparent protective cover 18 that is fixed to the flange 61 of the upper case 11 by means of the double-coated tape 62. As discussed above, this double-coated tape 62 clearly is not a resilient pad. Indeed, the Ohgami reference states that the transparent protective cover 18 is "fixed to the upper surface of the flange 61 through [the] double-coated tape 62," indicating that the double-coated tape 62 is not resilient. See Ohgami, col. 6, ll. 65-67 (emphasis added).

Additionally, the Ohgami reference does not teach or suggest "a display having a resilient pad." The double-coated tape 62 is separate from the display device 58. See *id* at Fig. 8. The double-coated tape 62 secures the transparent protective cover 18 to a flange 61. See *id*. Indeed, the double-coated tape 62 disclosed by the Ohgami reference is not even in contact with the display device 58.

Moreover, the Hashimoto reference fails to cure these deficiencies. The Hashimoto reference discloses a protective glass 15 mounted in a frame member 8 without a pad of any sort, let alone a resilient pad. Further, the Hashimoto reference does not teach or suggest a "display having a resilient pad." Indeed, the Hashimoto reference does not even disclose where a display would be disposed relative to the frame member 8 or protective glass 15. Accordingly, the Ohgami reference and the Hashimoto reference, taken alone or in

hypothetical combination, cannot render the Applicants' claims obvious.

Claim 17

Claim 17 depends from claim 16. The rejection of claim 17 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of claim 16 under Section 102. In particular, the Ohgami reference does not disclose or suggest "applying a shock absorbing pad to the portable computer housing," as recited by claim 16. (Emphasis added.) Conversely, as discussed above, the Ohgami reference discloses a transparent protective cover 18 that is fixed to the flange 61 of the upper case 11 by means of the double-coated tape 62.

Additionally, the Ohgami reference does not teach or suggest that "the shock absorbing pad is disposed between the display panel and the portable computer housing." As illustrated by Fig. 8, the double-coated tape 62 is located between the protective cover 18 and the external side of the flange 61, while the display device 58 is located on the internal side of the flange 61. *See id* at Fig. 8. Thus, the double-coated tape 62 is not disposed between the display device 58 and the housing. *See id*. Therefore, for this reason also, the Ohgami reference does not teach or suggest all the features of claim 16. Accordingly, the steps recited by claim 16 are not inherently necessitated by the structure of Ohgami.

Moreover, the Hashimoto reference fails to cure these deficiencies. The Hashimoto reference discloses protective glass 15 mounted in a frame member 8 without a pad. Without a pad, the Hashimoto reference clearly does not teach disposing a pad in any particular location. Thus, neither cited reference teaches or suggests either a shock absorbing pad or locating such a pad between the display panel and the portable computer housing. Accordingly, the Ohgami reference and the Hashimoto reference, taken alone or in hypothetical combination, cannot render the Applicants' claims obvious.

Claim 10

With respect to independent claim 10, the present rejection is flawed for a number of reasons. The Ohgami reference and the Hashimoto reference do not teach or suggest, alone or in hypothetical combination, "a shock absorbent pad disposed underneath the glass panel," as recited by independent claim 10. (Emphasis added.) Conversely, as previously discussed, the Ohgami reference teaches a transparent protective cover 18 that is fixed to the flange 61 of the upper case 11 by means of the double-coated tape 62. Indeed, the Ohgami reference does not disclose or suggest any shock absorbent pad, let alone a shock absorbent pad disposed underneath the protective cover 18. Further, Hashimoto reference does not cure these deficiencies. As discussed above, the Hashimoto reference discloses protective glass 15 mounted in a frame member 8 without a pad of any sort. In view of these deficiencies, the Ohgami reference and the Hashimoto reference, taken alone or in hypothetical combination, cannot render obvious claim 10 or the claims that depend therefrom.

Second Rejection

In the Final Office Action, the Examiner rejected claims 2, 5-6 and 17 as obvious over the Yang reference in view of the Hashimoto reference. Applicants respectfully traverse this rejection.

Absent the Yang reference, the Hashimoto reference is by definition insufficient to support the present rejection. As discussed above, Applicants have sworn behind the Yang reference under 37 C.F.R. § 1.131. Standing alone, the Hashimoto reference fails to disclose or suggest all the features of the present claims. In view of the inadequacies of the Hashimoto reference and the removal of the Yang reference, Applicants respectfully request withdrawal of this rejection and allowance of the present claims.

For these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

New Claims

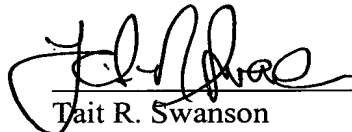
As noted above, the Applicants hereby add new claims 28-39. The Applicant submits that claims 28-39 depend from independent claims 1, 10, 16, and 21 and, thus, are believed to be allowable for the reasons discussed above and also in virtue of the features recited in each respective claim. For at least these reasons, the Applicants respectfully request allowance of new claims 28-39.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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